

10/712,942

P-4628-3-C1-3-D1

REMARKS

Reconsideration of the present application and entry of the amendment are respectfully requested. Claims 10 to 28 are currently pending, and no claims have been amended.

The Office Action mailed May 4, 2004 addressed claims 10 to 28. Claims 10 to 28 were rejected.

Claims 10 to 12, 14 to 18, 21, 22, 25 and 26 were rejected under 35 U.S.C. § 102(b) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over Nesbitt (4,431,193). The Examiner stated that Nesbitt discloses a golf ball comprising a core, an inner cover layer, and an outer cover layer. The Examiner further stated that the COR of the core is 0.770, the COR of the core and inner cover layer is 0.800 or more, and Applicant's COR of 0.770 or more for the ball is an inherent feature of Nesbitt. The Examiner stated that Nesbitt further discloses the inner cover layer is made from a hard, high flex modulus resin such as Surlyn 1605, which has a Shore D of 62, and the outer cover is made from a soft, low flexural modulus resin such as Surlyn 1855, which has a Shore D hardness of 55. The Examiner concluded that since the materials are the same, the spin factor and PGA compression are inherent features.

Applicants respectfully disagree with the Examiner. Nesbitt discloses a golf ball comprising a core and a multi-layer cover, and the inner cover layer comprises a hard, high flexural modulus ionomer, and the outer cover layer comprises a soft, low flexural modulus ionomer. Nesbitt uses as examples of suitable materials for use in the cover layers Surlyn® 1605 and 1855 ionomers, high and low flexural modulus ionomers respectively, but Nesbitt does not disclose or claim the specific Shore D of the cover layers, nor does Nesbitt limit the cover layers to materials having a specific Shore D. Additionally, Nesbitt does not disclose or claim a PGA compression of 100 or less, a spin factor, or the COR.

Applicants respectfully submit that the burden is on the Examiner to provide a basis in fact and/or technical reason to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the prior art. Inherency must be a necessary result and not merely a possible result. Applicants

10/712,942

P-4628-3-C1-3-D1

respectfully submit that the Examiner has failed to support the inherency determination with any facts or technical reasoning. Applicants' specification includes example golf balls made using the materials disclosed in Nesbitt, and these balls do not meet the COR limitations. See, for example, Examples 3 and 4 and Tables 16, 17 and 18, where golf balls representing the golf ball of Nesbitt are produced, and the COR is considerably lower than that of the inventive golf balls. Therefore, Applicants respectfully submit that contrary to the assertions of the Examiner, the spin factor, COR and PGA compression are not obvious and/or inherent.

For at least these reasons, Applicants respectfully submit that claims 10 to 12, 14 to 18, 21, 22, 25 and 26 are not anticipated by, or in the alternative, obvious over Nesbitt. Applicants therefore respectfully request that the Examiner reconsider and withdraw the rejection of claims 10 to 12, 14 to 18, 21, 22, 25 and 26 under 35 U.S.C. § 102(b) or alternatively, under 35 U.S.C. § 103(a).

Claims 13, 19, 20, 23, 24, 27 and 28 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nesbitt in view of Isaac (US 3,989,568). The Examiner stated that Nesbitt discloses the invention as shown above but fails to disclose a polyurethane outer cover. The Examiner concluded that one skilled in the art would substitute the polyurethane cover of Isaac in the golf ball of Nesbitt to obtain a golf ball with good click and feel.

Applicants respectfully submit that the Examiner has failed to make out a *prima facie* case of obviousness. As discussed above, Nesbitt does not disclose Applicants' invention. Isaac discloses golf balls having a single cover layer formed from polyurethane prepolymers having at least two different reaction rates so that half shells can be formed in one reaction, and the cover may be cured about the core in a second reaction. Isaac does not disclose a multi-layer cover, or more particularly, a multi-layer cover having a polyurethane outer cover layer, or an outer cover layer comprising reaction-injection-molded polyurethane.

Applicants respectfully submit that there is no motivation to combine Nesbitt, which discloses and teaches golf balls having a specific type of multi-layer cover, with Isaac, which teaches golf balls having a single layer cover. At most, it might have

10/712,942

P-4628-3-C1-3-D1

been obvious to try to make the golf ball of Nesbitt using a polyurethane cover, but obvious to try is not the correct standard for obviousness. One skilled in the art would not be motivated to make the golf ball of Nesbitt using the cover of Isaac since the entire focus of Nesbitt is on a specific type of improved multi-layer ionomer cover for a golf ball. There is no motivation, teaching or suggestion to combine Isaac with Nesbitt because Isaac is directed to a particular type of polyurethane cover made from curing agents having different reaction rates, and the cover of Isaac is a single layer cover with very different properties from the multi-layer cover of Nesbitt. Even if the cover of Isaac was substituted for the cover of Nesbitt, a golf ball having a single layer polyurethane cover would be produced, not a golf ball having a polyurethane outer cover layer. Applicants' golf ball is not disclosed even if Nesbitt and Isaac are combined as suggested by the Examiner because neither Nesbitt nor Isaac, alone or in combination, discloses Applicants' COR ranges.

For at least these reasons, Applicants respectfully submit that claims 6, 13, 19, 20, 23, 24, 27 and 28 are not obvious under 35 U.S.C. § 103(a) over Nesbitt in view of Isaac. Applicants therefore respectfully request that the rejection of claims 6, 13, 19, 20, 23, 24, 27 and 28 under 35 U.S.C. § 103(a) as obvious over Nesbitt in view of Isaac be reconsidered and withdrawn.

Claims 10 to 28 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 42 of U.S. Patent No. 6,213,894. The Examiner stated that although the conflicting claims are not identical, they are not patentably distinct from each other because the present invention is anticipated by the '894 patent.

Although Applicants respectfully disagree, Applicants will file a terminal disclaimer once the other rejections have been overcome.

The Examiner is invited to telephone Applicants' attorney if it is deemed that a telephone conversation will hasten prosecution of the application.

10/712,942

P-4628-3-C1-3-D1

CONCLUSION

Applicants respectfully request reconsideration and allowance of each of the presently rejected claims, claims 10 to 28. Applicants respectfully request allowance of claims 10 to 28, the claims currently pending.

Respectfully submitted,

THOMAS J. KENNEDY, III ET AL.

Customer No. 24492
Phone: (413) 322-2937

Date: July 13, 2004

By: Michelle Bugbee
Michelle Bugbee, Reg. No. 42,370
Attorney for Applicants
The Top-Flite Golf Company
A wholly-owned subsidiary of Callaway Golf Company
425 Meadow Street
P.O. Box 901
Chicopee, MA 01021-0901